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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,610	06/20/2001	Takashi Ishitani	70820-56140	5340

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EXAMINER	
SHINGLES, KRISTIE D	
ART UNIT	**PAPER NUMBER**
2141	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/885,610	ISHITANI, TAKASHI	
	Examiner	Art Unit	
	Kristie Shingles	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 June 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 June 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *6/20/01*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-50 are pending.

Claim Objections

1. Claim **42** is objected to because of the following informalities: "device of 41" should read "device of claim 41" (pg.69 line 3). Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims **1-34, 36-39** and **41-50** are rejected under 35 U.S.C. 102(e) as being anticipated by Rudy et al (USPN 6,360,252).

a. Per claim **1**, Rudy et al teach an electronic mail transmission/reception system for communicating data between an electronic mail creating/sending device and an electronic mail receiving/reproducing device via a network, wherein: said electronic mail creating/sending device comprises:

- an electronic mail creating means creating multimedia data including attached data representing an image, voice/sound, or the like (Abstract; attachments may take the form of text, images, audio etc.); and

- an ID generating means generating an ID corresponding to the attached data such that said electronic mail creating/sending device sends the generated ID instead of the attached data (Abstract and Fig.1; system generates a user-understandable descriptor that is emailed to the user instead of the attachment), and

- said electronic mail receiving/reproducing device comprises: a real data generating means generating real data representing an image, voice/sound or the like corresponding to the ID such that said electronic mail receiving/reproducing device reproduces the image, voice/sound or the like represented by the real data (Abstract; server obtains and generates real data for the rendering device representing the attachment corresponding to the descriptor).

b. Claims **12, 22, 31, 36** and **41** contain limitations that are substantially equivalent to claim 1 and are therefore rejected under the same basis.

c. Per claim **43**, Rudy et al teach an Internet access device comprising:

- a real data generating means for generating real data representing image, voice/sound or the like corresponding to an ID representing attached data representing image, voice/sound or the like included in multimedia data (Abstract; server generates real data representing the attached data in formats including text, image, audio, etc);

- a real data acquiring means for acquiring real data corresponding to the ID from a specific server or a server designated by a URL when the real data generating means cannot generate the real data corresponding to the ID (col.11 lines 38-60; server can be accessed via URL for real data acquisition); and

- a reproducing means for reproducing the real data (Abstract; real data is reproduced for the client/user on the rendering device).

d. Per claim **2**, Rudy et al teach the electronic mail transmission/reception system of claim 1, wherein the ID generating means generates an ID based on a category of attached data (Abstract; descriptor can be based on selected categories of rendering options).

e. Per claim **3**, Rudy et al teach the electronic mail transmission/reception system of claim 1, wherein a server connected to the network comprises an ID generating means generating an ID corresponding to attached data such that the server sends the ID instead of the attached data to said electronic mail receiving/reproducing device (Abstract; server generates the user-understandable descriptor that corresponds to the email attachment and sends the descriptor instead of the attachment).

f. Claim **13** contains limitations that are substantially similar to claim 3 and is therefore rejected under the same basis.

g. Per claim **4**, Rudy et al teach the electronic mail transmission/reception system of claim 1, wherein the real data is identical to the attached data (col.3 line 10-col.4 line 18, col.24 lines 7-18 and col.25 lines 24-36; the real data can be the attached data or a reformatted version of the attached data capable of being displayed on the rendering device).

h. Claims **5, 14, 15, 23, 24, 32, 37** and **38** contain limitations that are substantially similar to claim 4 and are therefore rejected under the same basis.

i. Per claim **6**, Rudy et al teach the electronic mail transmission/reception system of claim 3, wherein the e-mail creating/sending device further comprises an ID acquiring means which, when its own ID generating means fails to generate an ID corresponding to attached data, inquires of the server about an ID corresponding to the attached data to acquire the ID corresponding to the attached data from the server such that the e-mail creating/sending device sends the ID acquired from the server instead of the attached data (Abstract; client machine may request the descriptor as a selectable item, thus the selectable item is sent from the server to the client instead of the attachment).

j. Claims **16, 25** and **33** contain limitations that are substantially equivalent to claim 6 and are therefore rejected under the same basis.

k. Per claim **9**, Rudy et al teach the electronic mail transmission/reception system of claim 3, wherein the server sends the attached data, the ID, or another ID belonging to the same category as the ID to the e-mail receiving/reproducing device depending on ability of the e-mail receiving/reproducing device or at a request thereof (col.3 line 53-col.4 line 48; the server sends the attachment or descriptor of the email depending on the capabilities of the user's rendering device).

l. Claims **19** and **28** contain limitations that are substantially equivalent to claim 9 and are therefore rejected under the same basis.

m. Per claim **7**, Rudy et al teach the electronic mail transmission/reception system of claim 3, wherein the e-mail creating/sending device has a data/ID acquiring means which, when there is a request for attached data other than attached data corresponding to an ID which can be generated by the ID generating means of the e-mail creating/sending device, acquires such attached data and the ID corresponding to the attached data from the server (Abstract and col.8 lines 49-67; client can request attached data from server and receive the output version of the data for display on the rendering device).

n. Claims **17, 26** and **34** contain limitations that are substantially equivalent to claim 7 and are therefore rejected under the same basis.

o. Per claim **8**, Rudy et al teach the electronic mail transmission/reception system of claim 3, wherein the e-mail receiving/reproducing device has a real data acquiring means which, when the real data generating means of the e-mail receiving/reproducing device fails to generate

real data corresponding to an ID, inquires of the server about real data corresponding to the ID to acquire the real data corresponding to the ID from the server such that the e-mail receiving/reproducing device reproduces the real data acquired from the server (col.7 line 66-col.8 line 67; client can inquire/request attached data from server and receive the output version of the real data that corresponds to the client version—which only includes the descriptor—for display on the rendering device).

p. Claims **18, 27** and **39** contain limitations that are substantially equivalent to claim 8 and are therefore rejected under the same basis.

q. Per claim **10**, Rudy et al teach the electronic mail transmission/reception system of claim 1, wherein the ID is part of HTML e-mail, and the ID can be identified by tags enclosing the ID at its front and back (col.7 line 23-col.8 line 6, col.21 line 14-39 and col.26 lines 54-58; descriptors identify the attached data and can appear in various formats in the client version email, depending on the content of the attachment).

r. Claims **11, 20, 21, 29** and **30** contain limitations that are substantially similar to claim 10 and are therefore rejected under the same basis.

s. Per claim **42**, Rudy et al teach the electronic mail transmission/reception device of 41, comprising: a recognizing means which, upon receiving multimedia data including an ID and attached data corresponding to the ID in a prescribed format, recognizes the ID and the attached data while associating them with each other, said ID generating means being able to generate the ID associated with the attached data recognized by the recognizing means (col.8 line 7-67; the client machine is able to recognize and make the appropriate association with the multimedia attachment descriptor client version email and the output version email for the rendering device).

t. Per claim **44**, Rudy et al teach the recording medium containing a program for making computers function as the electronic mail creating means, the ID generating means and the real data generating means of the electronic mail transmission/reception system of claim 1 (col.7 line 60-col.8 line 48, col.9 lines 11-67, col.26 lines 10-67 and col.27 line 15-col.29 line 8; system comprises client machines and servers with storage mediums and program code for creating and transmitting emails, for generating descriptors of the real data and acquiring real data).

u. Claims **45-50** contain limitations that are substantially similar to claim 44 and are therefore rejected under the same basis.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims **35** and **40** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudy et al in view of Luzeski et al (USPN 6,404,762).

a. Per claim **35**, Rudy et al teach the device of claim 31 as applied above, yet fail to distinctly teach the electronic mail creating/sending device of claim 31, further comprising an ID registering means storing IDs and attached data corresponding to the IDs in categorized manner,

and for a new attached data, identifying a category of the data, allocating an ID to the data and registering the data and the ID. However, Luzeski et al teach the use of multimedia containers and storage mediums for storing and cataloging attachment identifiers and attached data (col.16 line 50-col.18 line 38).

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to store and catalogue attached data and corresponding identifiers for attached data for the purpose of maintaining a current collection of the attached data and IDs useful in archiving for future access or queries. One skilled in the art would have been motivated to generate the claimed invention with a reasonable expectation of success.

b. Per claim **40**, Rudy et al teach the device of claim 36 as applied above, yet fail to teach the electronic mail receiving/reproducing device of claim 36, further comprising a real data search means which, based on IDs and corresponding real data stored in categorized manner, searches for data belonging to a higher order category of a received ID or representative data if there is no real data corresponding to the received ID. However, Luzeski et al teach the method of searching for attachments/real data, based on the stored and corresponding categorized IDs and data (Abstract, col.11 lines 41-53 and col.12 line 57-col.13 line 20).

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to permit real data search means for the purpose of retrieving the attached data for the client/user. One skilled in the art would have been motivated to generate the claimed invention with a reasonable expectation of success.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Scheussler et al (USPN 6,366,950) disclose a system and method for verifying users' identity in a network using email communication.

b. Miller et al (USPN 6,421,707) disclose a wireless multi-media messaging communications method and apparatus.

c. Donoho et al (USPN 6,604,130) disclose a relevance clause for computed relevant messaging.

d. Mertama et al (USPN 6,629,130) disclose a method and apparatus for processing electronic mail.

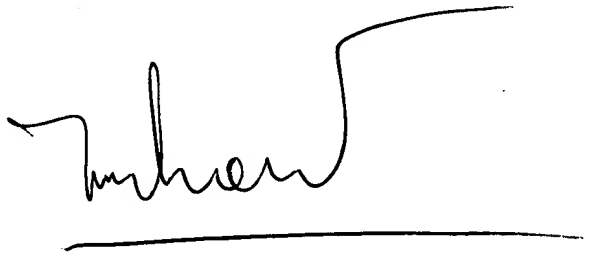
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 703-605-4244 (or 571-272-388 after 10/26/04). The examiner can normally be reached on Monday-Friday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 703-305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie Shingles
Examiner
Art Unit 2141

kds



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PRIMARY EXAMINER